

REMARKS

In response to the Office Action, claims 1-3, 11, 12 and 17 have been amended. Claim 10 has been cancelled. In view of the amendment to claim 17, the drawing requirement is now moot.

The rejection of claims 1, 2, 4, 5, 10, 12, 14-16 and 18 under 35 U.S.C. 102(e) as anticipated by Snapp, et al., is traversed. The Section 103(a) rejections based on Snapp, et al., are also traversed. While the Examiner has specified that the reliance on this reference is under Section 102(e), he has relied on Pub. No. US 2003/0069693 A1 (hereinafter the "Published Application" or "Published") which was published April 10, 2003, some 21 months after Applicants' filing date. This is tantamount to a Section 102(a) rejection, which is clearly improper. To be proper under Section 102(e) the Examiner must rely exclusively on the contents of provisional application No. 60/262,147 (hereinafter the "Provisional Application" or "Provisional"), because it is the only Snapp et al. document that has a date prior to Applicant's filing date, and assume the Published Application does not exist. Thus, the Examiner's references to various sections of Snapp et al. must be to the Provisional, not to the Published Application.

A complete copy of the Provisional Application, as received from the U.S. Patent and Trademark Office is enclosed as Exhibit 1. Attached as Exhibit 2 is the declaration of Applicant's attorney attesting to the contents of Exhibit 1. As is abundantly clear from only a cursory review, the Provisional Application does not have the same disclosure as the Published Application. Thus, the Examiner cannot presume that the texts of the Provisional and Published Applications are the same.

Reliance on Snapp et al. under 35 U.S.C. §102(e) is improper for two reasons. First, as indicated above, the Provisional Application does not have the same disclosure as the Published Application. Secondly, Snapp et al. do not disclose a single invention, but rather a geographic pointing device onto which is tacked a series of other partial disclosures for other/different inventions. See page 36 of 54.

As is clear from the MPEP, the Provisional can only be relied on "if it has proper support for the subject matter as required by 365 U.S.C. 119(e) or 120." As set forth in Section 706.029(f)(1) of the MPEP:

For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims priority under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C. 119(e) or 120. [emphasis added]

As is apparent from only a casual inspection of Exhibit 1, the Provisional Application differs from the Published Application in that it has no drawings and is, thus, incomplete. Secondly, as is also evident from a casual inspection, the Provisional is a collection of separate disclosures. Most, if not all, of these separate disclosures are not enabling. In this regard, please note the following groupings in the Provisional:

1. Pages 2 of 54 - 28 of 54;
2. Pages 29 of 54 - the top of 34 of 54;
3. Pages 34 of 54 - 35 of 54; and
4. Pages 36 of 54 - 52 of 54.

For the sake of argument, pages 2 of 54 - 28 of 54 appear to constitute an integrated patent application. This section includes, in order, BACKGROUND OF THE INVENTION, BRIEF SUMMARY AND OBJECTS OF THE INVENTION, BRIEF DESCRIPTION OF THE DRAWINGS (but no drawings), and DETAILED DESCRIPTION OF THE INVENTION. Also, for the sake of argument (Applicants have not undertaken a detailed side-by-side comparison), these 26 pages appear to correspond to paragraphs [0002] through [0072] of the Published Application. The paragraph

bridging pages 27 of 54 - 28 of 54, which is not in the Published Application, is typical of the boilerplate which concludes preferred embodiment descriptions in patent applications.

As is clear from pages 2 of 54 through 28 of 54, the "invention" described in these 26 pages relates to:

... a geographic pointing 'device that includes a GPS receiver, a digital compass and informational databases. When a user activates the device, the user's position and direction are displayed on a displayed map, as the user travels, the map and direction are continually updated to reflect the movement. Geographically encoded information concerning points of interest is displayed on the map in response to user preferences.

See page 5 of 54.

The foregoing disclosure does not relate to a compact, self-contained surveillance unit having, as set forth in Applicants' claim 1, inter alia:

- (b) optics means for collecting radiation and generating images, said optics means attached to said housing means; or
- (d) means, attached to said housing means, for sending and receiving communications from said unit.

Pages 29 of 54 - 34 of 54 constitute a partial, but largely incomplete, draft of a separate patent application (hereinafter "Second Application"). Please note that it includes, in order, ABSTRACT, INVENTION REFERENCES CITED, CLAIMS, DESCRIPTION, BACKGROUND OF THE INVENTION, A. Field of the Invention, B. Description of Related Art, BRIEF DESCRIPTION OF THE DRAWINGS, and DETAILED DESCRIPTION OF THE PREFERRED AND ALTERNATIVE EMBODIMENTS OF THE INVENTION. As set forth on page 29 of 54, the ABSTRACT refers to:

A location receiver direction sensor combination receiver apparatus for location determination and orienting with a plurality of points and axis of reference. The apparatus includes a global positioning system (GPS) for determining the geographic location, a direction sensor (MS) for

determining direction or bearing and a trigger component for activating the apparatus.

The Field Of The Invention, pages 32 of 54 – 33 of 54, which relates back to the ABSTRACT and CLAIMS of the Second Application states, in part:

The present invention relates generally to the field of systems for tracking and positioning an entity or target, such as a vehicle or person, by surveillance or tracking persons or stations. More particularly, this invention relates to a mobile tracking and positioning system in which a mobile target is tracked by two or more mobile tracking and positioning stations continuously as all the elements of the system (i.e., the target and the tracking and positioning stations) move about or over the surface of the earth.

There are no drawings, let alone a brief description. Finally, the only statement below the heading DETAILED DESCRIPTION ... OF THE INVENTION (page 34 of 54) is:

determining the position of the [station] on (or above) the surface of the earth.

This is followed by the statement: “-----End of Patent ----.”

Pages 36 of 54 - 52 of 54 constitute pages 3-19 of a fax from "Madison River Tech," broken down into 22 separate, partial, incomplete disclosures labeled A (on page 36 of 54) through V (on page 52 of 54). Immediately above A is the statement:

Each of the following are believed to be patentable inventions based on patent research that was done by the MRT IP team.

Generally, each of these "patentable inventions" has the format of:

Title
Original Inventor
Original Invention Idea
How It Works
What's Unique
Value Proposition
Obvious Exclusions
Description & Claims

Many have text following the heading "Description & Claims." Some have text after the heading "How it Works" while others do not. P (pages 44 of 54 – 47 of 54) and Q (pages 48 of 54 – 51 of 54) appear to be outlines of possible additional patent applications. Neither include any substantive text under the heading "Detailed Description of the Invention."

The Examiner's reliance on the Published Application, even if it were proper, requires one to jump in hop scotch like fashion, from: [0078] back to [0012]; then to [0028] or [0166] or [0171]; then back again to [0015]; then forward again to [0035] or [0134]; finally ending up at [0063]. In total, just on the 102(e) rejection, the Examiner has relied on 14 different paragraphs of the Published Application a total of 26 times.

As is clear from the Provisional Application, which is the only document the Examiner can rely on, the 102(e) rejection is based on four (4) different inventions and paragraphs which do not exist in the Provisional Application. Specifically,

1. Eight of the paragraphs of the Published Application referenced in the Section 102(e) rejection ([0012], [0015], [0030], [0031], [0032], [0035], [0063], and [0072]) appear to correspond¹ to the disclosure encompassing pages 2 of 54 - 28 of 54 of the Provisional.
2. There is no paragraph in the Provisional Application corresponding to paragraph [0073].
3. To the extent paragraph [0078] of the Published Application has support in the Provisional, it would appear to be based on the paragraph bridging pages 32 of 54 - 33 of 54, between the heading "BACKGROUND OF THE INVENTION, A. Field of the Invention" and "B. Description of Related Art." It relates to an outline/partial draft of a patent application on pages 29 of 54 - 34 of 54. On its face, this

¹ Again, Applicants have not made a side by side comparison and are not representing that they are identical in both the Provisional and the Published Applications. Further, the text of the Provisional is the only text that may be relied on.

paragraph of the Provisional is inconsistent with the associated ABSTRACT, the CLAIMS, and the disclosure of pages 2 of 54 - 28 of 54. Also, there is no associated detailed disclosure or drawings. See the top of page 34 of 54.

4. No paragraph corresponding to paragraph [0134] exists in the Provisional.
5. There is a paragraph, at the top of pages 45 of 54 which corresponds to paragraph [0166]. However, in the context of the Provisional, which is the only Snapp et al. document upon which the Examiner can rely, it is an "ABSTRACT" related to "P. Geographic power device." (top of page 44 of 54). It does not relate to the disclosure of pages 2 of 54 - 28 of 54.
6. Finally, there is no paragraph in the Provisional that corresponds to paragraph [0171].

In view of the foregoing the rejection of claims 1, 2, 4, 5, 10, 12, 14-16 and 18 under 102(e) is clearly improper as the Provisional:

1. does not disclose a single unified invention, but a plurality of different inventions;
2. does not disclose all the paragraphs which the Examiner has referenced in the Published Application; and
3. does not disclose the limitations set forth in Applicants' claim 1.

The various rejections of claims 3, 6-8, 9, 11, 13, 17 and 19 under Section 103(a) based on Snapp et al. are all improper for the same reasons that reliance on this reference under Section 102(e) is improper. See above.

The rejections of claims 6-8, 11, 13 and 19 are additionally traversed. In each of paragraphs 6, 8, 9 and 11 of the Office Action the Examiner states, "Snapp does not specifically disclose ... ", followed by the statements:

"However, it is well known to incorporate accelerators into global positioning systems" (Paragraph 6);

"However, multi-mode patch antennas are well known" (paragraph 8);

"However it is well known to use FPGA's" (paragraph 9); and

"However, touch pads are a well-known means for" (paragraph 11).

The foregoing rejections are essentially the same as the rejections of these same claims in the previous Office Action; the difference being that the use of the words "Official Notice" have been deleted. Applicants do not believe that this makes any difference as, both the previous and current rejections appear to be based on the personal knowledge of the Examiner.

It is submitted that none of the foregoing assertions that the missing element is "well known" are well known in the field of "surveillance units" (as set forth in parent claim 1). As set forth in MPEP Section 2144.03:

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."


Accordingly, pursuant to 37 CFR 1.104(d)(2), if the Examiner persists in these rejections Applicants call for an affidavit by the Examiner to support the above-noted assertions of common knowledge. 37 CFR 1.104(d)(2) provides:

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

In view of the foregoing, it is submitted that the claims are in condition for allowance.

Respectfully submitted,

RODEY, DICKASON, SLOAN, AKIN & ROBB, PA

By 

DeWitt M. Morgan

Reg. No. 26,488

Agent for Applicant

Rodey Dickason Sloan Akin & Robb, PA

P. O. Box 1888

Albuquerque, NM 87103-1888

(505) 768-7375

Date 3/11/04